

REMARKS:

Claims 1-37 are currently pending in the subject Application.

Claims 1-11, 13-21, 23-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,991,739 to Cupps, et al. ("*Cupps*") in view of U.S. Patent No. 4,971,406 to Hanson ("*Hanson*") and U.S. Patent No. 5,895,454 to Harrington ("*Harrington*").

Claims 12, 22, and 35 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*, and further in view of U.S. Patent No. 4,797,818 to Cotter ("*Cotter*").

The Applicant respectfully submits that all of the Applicant's arguments and amendments are without *prejudice* or *disclaimer*. In addition, the Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, the Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. The Applicant further respectfully submits that by not responding to additional statements made by the Examiner, the Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by the Applicant are considered sufficient to overcome the Examiner's rejections. In addition, the Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-11, 13-21, 23-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*. Claims 12, 22, and 35 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*, and further in view of *Cotter*.

The Applicant respectfully submits that the ***amendments to independent Claims 1, 13, 23, and 24 have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims.*** The Applicants further respectfully submit that amended independent Claims 1, 13, 23, and 24 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Cupps*, *Hanson*, *Harrington*, and *Cotter*, either individually or in combination. Thus, the Applicant respectfully traverses the Examiner's obviousness rejection of Claims 1-37 under 35 U.S.C. § 103(a) over the proposed combination of *Cupps*, *Hanson*, *Harrington*, and *Cotter*, either individually or in combination.

The proposed *Cupps-Hanson* Combination Fails to Disclose Various Limitations Recited in Applicant's Claims

The Applicant's claims, as amended, include limitations that are not taught, suggested, or hinted at in *Cupps* or *Hanson*, either individually or in combination. Specifically, the Applicant's amended independent Claims 1, 13, 23 and 24 include at least limitations regarding "***buyer delivery information***" and "***unaffiliated seller delivery information***", which are clearly not taught, suggested, or hinted at in either *Cupps* or *Hanson*. The Applicant respectfully submits that these limitations alone are sufficient to distinguish the Applicant's claims from *Cupps* and *Hanson*. The Applicant further respectfully submits that other patentable distinctions between the Applicant's claims and *Cupps* and *Hanson* likewise exist.

***Cupps* Fails to Disclose Various Limitations Recited in Applicant's Claims, as Acknowledged by the Final Office Action**

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Cupps* fails to disclose various limitations in amended independent Claim 1. Specifically the Examiner acknowledges that *Cupps* fails to disclose "***the real time delivery time be provided prior to a selection be made by the customer.***" (3 August 2007 Final Office Action, Page 2). (Emphasis Added). The Examiner also acknowledges, and the Applicant agrees, that *Cupps* and *Hanson* fail to disclose "***the real***

time delivery time communicated to the customer prior to a transaction being initiated". (3 August 2007 Final Office Action, Page 3) (Emphasis Added).

In the Response to Remarks section of the Office Action, it appears that the Examiner is asserting Official Notice in that "there is in fact no such thing" as "real time." (3 August 2007 Final Office Action, Page 4). ***The Applicant respectfully traverses the Examiner's assertion of Official Notice.***

It remains unclear upon what authority or evidence the Examiner makes such a sweepingly generalized statement that "there is in fact no such thing" as "real time." In fact, the only basis provided for the foregoing assertion is the Examiner's conclusory statement that "there will always be at least some lag such as in this case inputting the information." (3 August 2007 Final Office Action, Page 4). Notwithstanding the fact that the Examiner has failed to provide any evidence or authority tending to support the foregoing conclusory assertion, the Examiner nevertheless requests explanation as to "why the order going through an operator does not meet the limitation of the claim."

Specifically, in *Cupps*, information must pass from a buyer to an operator, from an operator to a seller, from a seller back to the operator, and from the operator to the buyer. These additional steps would not be required but for the presence of an operator. Moreover, such additional steps also have the direct effect of decreasing the efficiency of communications between a buyer and a seller, thereby increasing the amount of time in which a communication exchange may begin and conclude. Therefore, these additional steps preclude real-time "information identifying particular food items available from each of a plurality of unaffiliated sellers" being provided in "substantially real time." After all, the introduction of an operator not only adds an intervening party, but it likewise creates inefficiencies which necessarily disallow the existence of "substantially real time information." Therefore, as can be seen from the foregoing, *Cupps* does not disclose *inter alia*, at least the limitation of "substantially real-time availability information." Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Cupps* and amended independent Claim 1 cannot be made. The

Applicant therefore respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Cupps*.

***Cupps* Fails to Disclose Each and Every Limitations Recited in Applicant's Claims**

The Applicant respectfully submits that *Cupps* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a “*food order transaction broker operable to: receive a request for at least one particular food item from a buyer*”, as recited in amended independent Claim 1. Rather, *Cupps* teaches only a telephone system in which a “customer desiring a pizza, or any other type of food provided by the supplier, dials the number of the telephone center [10; the] incoming call is automatically assigned to an available at one of the CRTs 16 by the telephone service 28 employed by the center.” (Column 3, Lines 56-60). In contrast, amended independent Claim 1 provides a “*food order transaction broker operable to receive a request for at least one particular food item from a buyer*”. Accordingly, a buyer's request is received directly by Applicant's food order transaction broker, and does not go to a telephone center operator (a person) that has to selectively enter the customer information in the appropriate field in an order entry screen of an intermediate CRT (Column 3, lines 56-60) before it is ever processed by the computer as in the system of *Cupps*. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Cupps* and amended independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Cupps*.

***Hanson* Fails to Disclose Each and Every Limitations Recited in Applicant's Claims**

The Applicant further respectfully submits that *Hanson* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding “one or more databases containing ***buyer delivery information associated with each of a plurality of buyers, the buyer delivery*** information comprises information selected from the group consisting of a ***maximum delivery time preference of at least one of the plurality of buyers*** and an indication of how important the delivery time is to the at least one of the plurality of

buyers” and “a **food order transaction broker operable to receive a request** for at least one particular food item *from at least one of the plurality of buyers*; [and] **generate a list of one or more of the plurality of listed unaffiliated sellers of the requested particular food item** according to a **comparison of the requested particular food item** with the substantially real-time availability information for each unaffiliated seller and a **comparison of the unaffiliated seller delivery information for the buyer with the delivery area of each of the plurality of listed unaffiliated sellers**, the **list reflecting the pricing information for the requested particular food item for each listed unaffiliated seller**, and the **substantially real-time delivery time information for each of the plurality of listed unaffiliated sellers**”, as recited in amended independent Claim 1.

Rather, *Hanson* only discloses that an order entry station may be advised if an unusual delay in future deliveries is to be expected “so that customers can be advised accordingly”. (See Column 16, lines 66-68). In contrast, amended independent Claim 1 provides a “**food order transaction broker operable to: receive a request** for at least one particular food item *from at least one of the plurality of buyers*; [and] **generate a list of one or more of the plurality of listed unaffiliated sellers of the requested particular food item** according to a **comparison of the requested particular food item** with the substantially real-time availability information for each unaffiliated seller and a **comparison of the unaffiliated seller delivery information for the buyer with the delivery area of each of the plurality of listed unaffiliated sellers**, the **list reflecting the pricing information for the requested particular food item for each listed unaffiliated seller**, and the **substantially real-time delivery time information for each of the plurality of listed unaffiliated sellers**”.

Accordingly, Applicant’s “**food order transaction broker**” directly generates a list reflecting the substantially real-time delivery time information for each of the listed unaffiliated seller, and is **not communicated to the customer indirectly, by the person on the phone at the order entry station, as in the Hanson system**. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Hanson* and amended independent Claim 1 cannot be made. The

Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Hanson*.

***Harrington* Fails to Disclose Each and Every Limitations Recited in Applicant's Claims**

The Applicant respectfully submits that *Harrington* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding “one or more databases containing ***buyer delivery information associated with each of a plurality of buyers***, the buyer delivery information comprises information selected from the group consisting of ***a maximum delivery time preference of at least one of the plurality of buyers*** and an indication of how important the delivery time is to the at least one of the plurality of buyers” and “a ***food order transaction broker operable to: receive a request*** for at least one particular food item ***from at least one of the plurality of buyers***; [and] ***generate a list of one or more of the plurality of listed unaffiliated sellers of the requested particular food item according to*** a comparison of the requested particular food item with the substantially real-time availability information for each of the plurality of listed unaffiliated sellers and ***a comparison of the buyer delivery information for at least one of the plurality of buyers with the unaffiliated seller delivery information, the list reflecting*** the pricing information for the requested particular food item for each listed unaffiliated seller, and ***the substantially real-time delivery time information for each of the plurality of listed unaffiliated sellers***”, as recited in amended independent Claim 1.

Rather, *Harrington* only discloses that a user inputs delivery time criteria into the database interface. (See Column 5, lines 27-28). In contrast, amended independent Claim 1 provides a “***food order transaction broker operable to: receive a request*** for at least one particular food item ***from at least one of a plurality of buyers***; [and] ***generate a list of one or more of the plurality of listed unaffiliated sellers of the requested particular food item according to*** a comparison of the requested particular food item with the substantially real-time availability information for each unaffiliated seller and ***a comparison of the buyer delivery information for the buyer with the delivery area of each of the plurality of listed unaffiliated sellers, the list reflecting*** the pricing information for the

requested particular food item for each listed unaffiliated seller, and *the substantially real-time delivery time information for each of the plurality of listed unaffiliated sellers*". Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Harrington* and amended independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Harrington*.

The Office Action Fails to Properly Establish a Prima Facie case of Obviousness over the Proposed Cupps-Hanson-Harrington Combination

The Examiner notes in the Final Office Action that the United States Supreme Court has recently set forth a new legal standard to be employed in an obviousness situation. The Examiner notes that the Supreme Court has decided that "the combination of familiar elements according to known methods is **likely** to be obvious when it does no more than yield predictable results." (3 August 2007 Final Office Action, Page 6, citing *KSR Int'l v. Teleflex, Inc.*, No. 04-1350 (U.S.S.C. April 30, 2007)).

As an initial matter, Applicant respectfully submits that, in an obviousness situation, the **prior art must disclose each and every element of the claimed invention**, *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. Specifically, Applicant respectfully submits that each and every element of Applicant's claimed invention is **not** present in the prior art, either individually or in combination. In fact, Applicant respectfully submits that the prior art actually teaches away from combining the references.

Additionally, the Examiner does not adequately address the issue of motivation to combine references. The factual question of motivation is material to patentability, and cannot be resolved on **subjective belief and unknown authority**. *Id.* at 1434-35. **Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness.** *Id.* at 1434-35. It is clear that the Examiner cannot point to any portions of *Cupps*, *Hanson*, and *Harrington*, which contain the teaching, suggestion, or motivation to combine these references. Instead, on page 6

of the 3 August 2007 Final Office Action, the Examiner provides only conclusory statements about his own subjective belief about what he and other consumers would want to know before making a decision. The Examiner also apparently asserts Official Notice that it would have been “**common sense**” to provide a consumer with additional information. ***Applicant respectfully traverses the Examiner’s assertion of Official Notice.***

Moreover, the Examiner’s subjective belief and “common sense” arguments cannot support a finding of obviousness. Accordingly, since the Examiner cannot point to any portions of *Cupps*, *Hanson*, and *Harrington* and wants to rely instead on the general knowledge available to one of ordinary skill in the art, Applicant ***respectfully requests the Examiner to point to other specific prior art authority demonstrating the general knowledge available to one of ordinary skill in the art.***

Furthermore, it is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). ***The teaching or suggestion can not be based on applicant’s disclosure.*** The Applicant respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a). Thus, the Office Action fails to provide proper motivation for combining the teachings of *Cupps*, *Hanson*, or *Harrington*, either individually or in combination.

The Examiner Improperly Relies upon “Common Sense” and Official Notice

In addition to the foregoing, the Applicant respectfully submits that the Examiner has misstated the correct legal standards to be used in determining motivation to combine references, as well as taken improper Official Notice. ***Applicant respectfully traverses the Examiner’s assertion of Official Notice.***

The Examiner states that “it would simply have been common sense to provide the buyer with all the information for a more informed decision.” The Examiner has set for the

no authority or reasoning tending to substantiate this assertion. Moreover, Applicant are unfamiliar with the “Common Sense” doctrine and respectfully request that the Examiner point to the specific portion of 37 C.F.R., or the MPEP, that provides for the use of a “common sense” doctrine in determining motivation in an obviousness context.

In addition, ***the Applicant respectfully traverses the Examiner’s apparent taking of Official Notice*** that “its general knowledge that the more informed a buyer is the more likely the buyer is [sic] make the right decision thus leaving the buyer to use the system again.”

The Applicant respectfully traverses the purported Official Notice because the asserted facts, as best understood by the Applicant, are not supported by substantial documentary evidence or any type of documentary evidence and appear to be the Examiner’s opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, ***it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner’s conclusion.*** (See MPEP § 2144.03). The Applicant respectfully request the Examiner to produce authority for the Examiner’s purported Official Notice.

Only “in limited circumstances,” is it “appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection”. (MPEP § 2144.03). “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are *capable of instant and unquestionable demonstration as being well-known*. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘*capable of such instant and unquestionable demonstration as to defy the dispute*’ (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961)).” (MPEP § 2144.03(A)).

“It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a

rejection was based. *In re Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. (Emphasis added). As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).” (MPEP § 2144.03(A)).

“Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that *general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection*). Accordingly, the Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

The Applicant respectfully submits that ***the Office Action provides no documentary evidence to support the purported Official Notice taken by the Examiner***, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. The Applicant further submits that the Applicant have adequately traversed the Examiner’s assertion of Official Notice and direct the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual

statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of Applicant's claims based on the Examiner's Official Notice, the Applicant respectfully requests that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge the Applicant further request that the Examiner provide an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

The Applicant further respectfully submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Cupps*, *Hanson*, or *Harrington*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be "so that the customer could make **a more informed decision**" and "so that delivery time could be used by the customer as **a criteria for determining which food item to order** before beginning any transaction." (3 August 2007 Final Office Action, Page 3). The Applicant respectfully disagrees and further respectfully request clarification as to how the Examiner arrives at this conclusion. For example, how does "communicat[ing] the real time delivery time to the customer" relate to "make[ing] **a more informed decision**" or "as **a criteria for determining which food item to order**" and to what extent does the Examiner purport that "**a more informed decision**" or the purported "**criteria**" applies to the subject Application.

The Proposed *Cupps-Hanson-Harrington-Cotter* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 12, 22, and 35

For example, with respect to dependent Claim 12, this claim recites:

The system of Claim 1, wherein the broker is further operable to ***select the particular listed seller automatically according to at least the substantially real-time delivery time information for all of the listed sellers.*** (Emphasis Added).

In addition, *Cupps, Hanson, Harrington*, and *Cotter*, either individually or in combination, fail to disclose each and every limitation of dependent Claims 22 and 35.

The Office Action Acknowledges that *Cupps-Hanson-Harrington* Fails to Disclose Various Limitations Recited in Applicant's Claims

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Cupps, Hanson*, and *Harrington* fail to disclose the emphasized limitations noted above in dependent Claim 12. Specifically the Examiner acknowledges that *Cupps, Hanson*, and *Harrington* fail to disclose a ***system for brokering food order transactions among a plurality of unaffiliated sellers*** wherein the broker is further operable to ***select the particular listed seller automatically according to at least the substantially real-time delivery time information for all of the listed sellers***. (3 August 2007 Final Office Action, Page 4). (Emphasis Added). Nevertheless, the Examiner asserts that the cited portions of *Cotter* disclose the acknowledged shortcomings in *Cupps, Hanson*, and *Harrington*. The Applicant respectfully disagrees and traverses the Examiner's assertions regarding the subject matter disclosed in *Cotter*.

The Applicant respectfully submits that *Cotter* fails to disclose, teach, or suggest dependent Claim 12 limitations regarding a food order transaction broker operable to *select the particular listed seller automatically according to at least the substantially real-time delivery time information for all of the listed sellers*, as recited in dependent Claim 12. In particular, the Examiner equates the "*select[ing] the particular listed seller automatically*" recited in dependent Claim 12 with the computer system disclosed in *Cotter*. (3 August 2007 Final Office Action, Page 3). However, the computer system disclosed in *Cotter*, merely provides for operators to manually enter information into the computer system wherein the computer system is adapted to automatically assign incoming orders to the store best able to respond to those orders and ***does not include or is not even related to select the particular listed seller automatically according to at least the substantially real-time delivery time information***, as recited in dependent Claim 12. (Column 2, Lines 21-31). In contrast, the limitations recited in dependent Claim 12 provide

for a food order transaction broker operable to ***select the particular listed seller automatically according to at least the substantially real-time delivery time information for all of the listed sellers***. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Cotter* and dependent Claim 12 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish dependent Claim 12 from *Cotter*.

The Applicant's Claims are Patentable over the Proposed *Cupps-Hanson-Harrington-Cotter* Combination

As mentioned above, amended independent Claims 1, 13, 23, and 24 are considered patentably distinguishable over *Cupps, Hanson, Harrington, and Cotter*.

With respect to dependent Claims 2-12, 14-22, 25-35, 36, and 37: Claims 2-12 depend from amended independent Claim 1; Claims 14-22, 36, and 37 depend from amended independent Claim 13; and Claims 25-35 depend from amended independent Claim 24. As mentioned above, each of amended independent Claims 1, 13, 23, and 24 are considered patentably distinguishable over the proposed combination of *Cupps, Hanson, Harrington, and Cotter*. Thus, dependent Claims 2-12, 14-22, 25-35, 36, and 37 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-37 are not rendered obvious by the proposed combination of *Cupps, Hanson, Harrington, and Cotter*. The Applicant still further respectfully submits that Claims 1-37 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 1-37 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-37 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references***

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference** (or references when combined) **must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, **and not based on applicant's disclosure.** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, **there must be something in the prior art as a whole to suggest the desirability**, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding

common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed electronically herewith to facilitate the processing of this deposit account authorization. **The Director is hereby authorized to charge the \$810.00 RCE fee, to Deposit Account No. 500777.** Although the Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777.** If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777.**

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

25 October 2007
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

BOOTH UDALL, PLC
1155 W. Rio Salado Parkway, Suite 101
Tempe Arizona 85281
214.636.0799 (mobile)
480.830.2700 (office)
480.830.2717 (fax)
steven@boothudall.com

CUSTOMER NO. 53184